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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,486	08/07/2003	Tomoyuki Ohzeki	FSF-031421	1098

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EXAMINER	
CHEA, THORL	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,486	OHZEKI, TOMOYUKI	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2005*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-2, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uytterhoeven et al (US Patent No. 6,143,488). See the composition photothermographic material containing silver iodide at least 80 mole % in the abstract; the silver halide grains having $\leq$ 40 nm in column 6, lines 46-53. Uytterhoeven et al discloses the composition of the photothermographic material including the silver halide having silver iodide and grain size encompasses the scope of the claimed invention. The limitation such as ""wherein the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed, such that the non-

photosensitive silver halide includes the photosensitive silver halide" is directed to the claiming of the material by a process which fails to differentiate the composition of the material from prior art. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated by or would have been found obvious to the worker of ordinary skill in the art over Uytterhoeven et al.

4. Claims 3-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al as applied to claims 1-2, 18-20 above, and further in view of Ikienoue et al (US Patent No. 4, 152,160). Ikienoue et al discloses the use of silver behenate of 50 mol % or more to provide a thermally developable material with an improvement of freshness retention property without causing any adverse increase in both light discoloration and dark discoloration. It would have been obvious to the worker of ordinary skill in the art to use the silver behenate within having percentage within the scope taught in Ikienoue in the material of Uytterhoeven for same reason, and thereby provide a material as claimed.

5. Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al as applied to claims 1-2, 18-20 above, and further in view of Arai et al (US Patent No. 6,090,538). Arai discloses the polyhalogenate compound as antifoggant in columns 43-44; the phosphoryl compound in column 10, lines 15-35; the hydrazine compound in

columns 9-29; the phenol reducing agent in column 2, compound (A); the binder such as poly(vinyl butyral) in column 42, lines 1-14. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use known additives for photothermographic material taught in Arai et al in the material of Uytterhoeven et al with a reasonable expectation of achieving of improving the fogging property and photographic speed, and thereby provide an invention as claimed.

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al as applied to claims 1-2, 18-20 above, and further in view of either Goto et al (US Patent No. 6,787,298) or Farid et al (.US Patent No. 5,747,235). See compound of Goto et al in columns 2-4, and Farid in the abstract and columns 16-18. The compound having property as claimed and useful as sensitizer for silver halide emulsion. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the sensitizer taught in Goto et al or Farid et al for same reason, and thereby provide a material as claimed.

7. Claims 1-7, 10-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohzeki et al (US Patent No. 2003/0194659) See pages 70-72, claims 1-18; page 53, [0276] to [0282]; page 48, [0216] to [0224]. The material has same composition. The language such as "wherein the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed, such that the non-photosensitive silver halide includes the photosensitive silver halide" is directed to the claiming of the material by a process which fails to differentiate the composition of the material from prior art. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated by or would have been found obvious to the worker of ordinary skill in the art over Ohzeki et al.

8. Claims 1-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukui et al (US Patent No. 2003/0207216).

Fukui et al discloses a photothermographic material having composition as claimed. See the silver halide having total silver iodide content of 40 mol% to 100 mol% in the abstract; the silver halide having particle size of 40 nm on page 43, [0553]; non-photosensitive organic silver salt on page 43, [0561] to [0566]; the compound of Type 1 to Type 5 on page 5-6, [0106] to [0175]; the phosphoryl compound, on page 28, [0319] to [0318]; the polyhalogenate compound on page 33, [0394]; and reducing agent on page 25, [0293]. The language such as "wherein the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed, such that the non-photosensitive silver halide includes the photosensitive silver halide" is directed to the claiming of the material by a process which fails to differentiate the composition of the material from prior art. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re

Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated by or would have been found obvious to the worker of ordinary skill in the art over Fukui et al.

9. Claims 1-7, 10-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshioka (US Patent No. 2003/0235794). See silver halide having iodide content of 40 mole % to 100 mole % in the abstract; the phosphoryl compound on page 2, [0026]; the silver halide having particle size of 5 nm to 70 nm on page 3, second column; reducing agent on page 20; [0132]; and the polyhalogenate compound on page 33, [0269]. The language such as "wherein the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed, such that the non-photosensitive silver halide includes the photosensitive silver halide" is directed to the claiming of the material by a process, which fails to differentiate the composition of the material from prior art. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated by or would have been found obvious to the worker of ordinary skill in the art over Yoshioka.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-7, 10-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/238,611 ((US Patent No. 2003/0194659). Although the conflicting claims are not identical, they are not patentably distinct from each other because material claimed in the present claimed invention and in the copending application are similar eventhough the processing was not claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No.10/403,006 (US Patent No. 2003/0207216). Although the conflicting claims are not identical, they are not patentably distinct from each other because the material contains silver halide with similar iodide content from 40 mole % to 100 mol %. The process of forming the nonphotosensitive silver organic silver salt is directed to the claiming of the material by a process, and fails to differentiate the claimed invention from the claimed of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

13. Applicant's arguments filed February 17, 2005 have been fully considered but they are not persuasive for the reason set forth in the rejection above. The applicants argue that "In contrast, in the present invention, the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed. This difference in the method of forming a mixture of the silver halide and the organic silver salt actually results in a materially different photothermographic material, as explained in the enclosed Declaration."

The argument is related to the claiming of a material by a process such as set forth in the rejection. The process limitation fails to differentiate the composition of the claimed material vs the material disclosed in the applied prior art of record. It has been conventionally practice in the photographic art to form silver halide for photothermographic material using in-situ process or ex-situ. The ex-situe process is the use of the preformed silver halide grains mentioned claimed in the present claimed invention. It has been well understood in the art to use the preformed silver halide due to the ability to incorporate various metal components of physical structures into the AgX preparation before photothermographic formulation. These features add considerable flexibility to the sensitometry of the resulting photothermopgraphic material. By using Ex Situ, certain ions or complexes as dopants provides improved contrast, and lower Dmin, Therefore, the worker of ordinary skill in the art at the time the invention was made would preferred to use the Ex Situ rather than In Situ.

The Declaration submitted on February 17, 2005 fails to overcome the rejections above. The Declaration fails to show as to why the claimed material is not anticipated by or found prima facie obvious to the worker of ordinary skill in the art in the art. The Declaration is related to the process of formulation of coating composition containing silver halide and organic silver salt rather than showing the difference between the claimed material and that of the applied prior art of record. The silver halide may be well dispersed by mixing the preformed silver halide grain and organic silver salt. However, this is not necessarily meant that the claimed material differs from that of the applied prior art. This process have been conventionally known and practiced as Ex-situe process such as discussed above. Moreover, the Declaration is irrelevant to the applied prior art set forth in the office action of record.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tch-tcn
April 26, 2005

Thorl Chea
Primary Examiner
Art Unit 1752